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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,268	08/31/2000	Jian-Shiou Liaw	2648.63638	3084

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EXAMINER

CHOI, STEPHEN

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,268

Applicant(s)

LIAW, JIAN-SHIOU

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II in Paper No. 6 is acknowledged.

The traversal is on the ground(s) that both groups would not place an undue burden on the examiner since the respective groups have many common features, and a search for one group would likely overlap with a search for the other group. This is not found persuasive because inventions of group I and II have acquired a separate status in the art as set forth in the previous office action, the inventions are deemed distinct and there would be burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. The examiner respectfully requests Applicant to provide publication date of each documents listed in the information disclosure statement filed 12 February 2002.

Claim Objections

3. Claims 11 and 13 are objected to because of the following informalities:
Appropriate correction is required.

Claim 11 appears to recite that two connecting tubes are connected to a shaft. However, the connecting tube with a positioning collar is not attached to the shaft. It is attached to an extension rod. In claim 13, line 3, "a handle" should be --said handle--.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 14 are rejected under 35 U.S.C. 102(e) as anticipated by Galat (US 6,055,887) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Galat (US 6,055,887) in view of Applicant's Admitted Prior Art (AAPA).

Galat discloses all the positively recited elements of the invention including:

- a) a connecting tube having first and second ends wherein the first end of the connecting tube being connected to the shaft (e.g., a portion including 28);
- b) an extension rod having first and second ends wherein the first end of the extension rod being connected to the second end of the connecting tube (e.g., 26);

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c) a cylinder having a body end, an operating end, and a through hole wherein the body end of the cylinder being connected to the opening of the body, and the extension rod being rotatably fitted into the cylinder (e.g., 34).

It is noted that the claim does not preclude the connecting tube and the extension rod being an integral structure.

Or, in the alternative, if it is argued that the preamble gives life and meaning to the claim such that the phrase following "wherein" serves to further define the structure of the claimed extension assembly,

Although Galat teaches a positioning collar (e.g., 32), Galat fails to disclose a connecting **tube** with a positioning collar and a protective cover. AAPA discloses a connecting tube with a positioning collar and a protective cover. Given the teachings of AAPA, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a connecting tube with a positioning collar and a protective cover on the device of Galat in order to facilitate mounting of a tool and to shield the tool from coming in contact with an operator.

7. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galat (US 6,055,887) in view of Yamada (US 4,179,805) or, in the alternative, over Galat (US 6,055,887) in view of Applicant's Admitted Prior Art (AAPA) as applied to claim 11 above, and further in view of Yamada (US 4,179,805).

Galat (and AAPA in the alternative) discloses the invention substantially as claimed except for an adjustable handle assembly including a rotatable tube and a

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threaded rod. Yamada discloses a handle assembly (e.g., 20) including a rotatable tube (e.g., 21) and a threaded rod (e.g., 23). Given the teachings of Yamada, It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a handle assembly including a rotatable tube and a threaded rod on the device of Galat (the modified device of Galat in the alternative) in order to provide an additional adjustable support for an operator to stabilize the tool against vibration to facilitate maintaining the position of the tool against the workpiece while in use.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Galat (US 6,055,887) or, in the alternative, Galat (US 6,055,887) in view of Applicant's Admitted Prior Art (AAPA).

Galat (and AAPA in the alternative) discloses the invention substantially as claimed including a bearing (e.g., 40) except for a bearing mounted on the first end of the extension rod. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an additional bearing on the first end of the extension rod, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Suggs, Beutner, Jimerson et al., Van der Merwe, Tripp, Stanich et al., Badiali, Spiess, Frenkel, and Shiao are cited to show related devices.

10. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to S. Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday thru Friday between 9am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

SC
June 30, 2002


Stephen Choi
Patent Examiner
A.U. 3724